Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRAVERSAL AND REQUEST FOR RECONSIDERATION OF REQUIREMENTS FOR RESTRICTION AND ELECTION OF SPECIES

Dear Sir:

Applicants, through there undersigned attorneys, hereby traverse and request reconsideration of the requirements for restriction and election of species set forth in the Official Action dated April 15, 2005 in the above-identified patent application.

At the outset, it is noted that a shortened statutory response period of 1 month was set in the April 15, 2005 Official Action. Accordingly, the initial due date for response was May 15, 2005. A petition for a 1 month extension of the current response period is presented with this Traversal and Request for Reconsideration of Requirements for Restriction and Election of Species which is being filed before the expiration of the 1 month extension period.

The requirements for restriction and election of species in this case are plainly improper for failure to comply with relevant provisions of the Manual of Patent Examining Procedure (M.P.E.P.) pertaining to restriction of Markush claims.

As noted in M.P.E.P. §803.02, it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. It is further stated in M.P.E.P. §803.02 that unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

In the present case, the compounds of claims 1-12 clearly share a common utility, in that they are useful for treatment and prophylaxis of hepatitis C viral infections and associated diseases, and they share a substantial structural feature, namely, a bendzofuran nucleus. Moreover, in view of this substantial structural feature which the claimed compounds have in common, it appears that the Examiner's search with respect to one of the putative patentably distinct groups of compound claims would of necessity cover art areas that overlap with the other allegedly distinct groups of compounds. Thus, the concurrent examination of all twelve of the allegedly distinct groups of compounds in the present application should not materially affect the Examiner's workload.

Claims 13-15 (i.e. Group XIII) cannot reasonably be considered separately patentable from Groups I-XII, as the former claims are directed simply to compositions comprising compounds within the scope of Groups I-XII and a pharmaceutically acceptable carrier medium.

Notwithstanding, the prospect for later rejoinder, the subject matter of claims 17-22 and 27 (Group XV) should also be examined together with the compounds of Groups I-XII, in view of the Examiner's failure to make the showing required in M.P.E.P. §806.05(h)with respect to patentable distinctness of claims to a product and process of using.

As the April 15, 2005 Official Action fails to comply with established U.S. Patent and Trademark Office restriction practice guidelines, it is respectfully submitted that this requirement should be reconsidered and withdrawn, at least with respect to the subject matter of claims 1-15, 17-22, and 27.

In order to be fully responsive to the above-mentioned requirements, Applicants hereby elect the subject matter of Group I as set forth in the April 15, 2004 Official Action for examination in this application. Applicants further elect the species 5-cyclopropyl-2-(4-fluorophenyl)-6-[(2-hydroxyethyl)-methanesulfonylamino)-benzofuran-3-carboxylic acid methylamide, which is described in example 43 of this application.

Applicants' elections in response to the present requirements for restriction and election of species are without prejudice to their right to file one or more continuing applications, as provided in 35U.S.C.§121, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action or the merits of this application is respectfully requested.

Respectfully submitted,
DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By Patrick J. Hagan

Patrick J. Hagan,
PTO Registration No. 27,643

Telephone: (215) 563-4100